

REMARKS/ARGUMENTS

A spelling change and an element number identification change have been made to the specification and a wording change has been made to claim 9 to make this claim consistent with the wording of claim 8 from which it depends. This application was filed with formal drawing sheets 1-4 containing FIGS. 1-9, and informal sheet 5 containing FIGS. 10-12. Submitted herewith for approval are formal FIGS. 10-12.

The Examiner has imposed a restriction requirement requiring Applicant to elect a single disclosed species in the subject application for prosecution on the merits. The Examiner alleges that the application contains claims directed to the following patentably distinct species of the claimed invention:

Group 1, as shown in FIGS. 1-9; and

Group 2, as shown in FIGS. 10-12.

The Examiner requires Applicant under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner states that none of the claims appear generic.

All of the pending claims in this application are directed to an adjustable apparatus for installing a repair clamp on a pipe. This apparatus is shown in FIGS. 10-12. The pipe repair clamp installation tool shown in FIGS. 1-9, and referred to by the Examiner as Group 1, is not adjustable and is thus incapable of operating with a wide range of pipe repair clamp sizes and pipe diameters as is the adjustable tool recited in the pending claims of this application. One of the primary advantages of the adjustable pipe repair clamp installation tool shown in FIGS. 10-12 is

In re appln. of Jerry E. Elliott
Serial No. 10/701,219

its capability to install a wide range of pipe repair clamp sizes on pipes having a wide range of diameters. All of the pending claims, including independent claims 1 and 26, are directed to this inventive adjustable pipe repair clamp installation tool. There are, therefore, no pending claims in this application which are directed to the non-adjustable pipe repair clamp installation tool illustrated in FIGS. 1-9. Because all of the pending claims are directed to an adjustable pipe repair clamp installation tool and the pipe repair clamp installation tool shown in FIGS. 1-9, described by the Examiner as the Group 1 species of Applicant's invention, is non-adjustable, all of the pending claims read on the embodiment of Applicant's invention shown in FIGS. 10-12 and should be examined in this application. The non-adjustable pipe repair clamp installation tool shown in FIGS. 1-9 is the subject of Applicant's prior application serial No. 10/393,820 filed on March 21, 2003, which issued as U.S. Patent No. 6,837,522 on January 4, 2005. This application is a continuation-in-part application of Applicant's aforementioned earlier application as stated on the first page of the specification of this application.

Independent claims 1 and 16 differ in their description of the arrangement for permitting the adjustable pipe repair clamp installation tool to accommodate different size repair clamps and pipes of various diameters. More specifically, independent claim 1 recites "an adjustable mechanism for adjusting spacing between said arm and said clasp to accommodate a range of sizes of the repair clamp and diameters of the pipe." Independent claim 26 recites a "movable member, wherein the position of said arm relative to said clasp may be adjusted for engaging repair clamps having a range of sizes for positioning on pipes having a range of diameters." Independent claims 1 and 26, thus, are different definitions of the same disclosed subject matter,

In re appln. of Jerry E. Elliott
Serial No. 10/701,219

i.e., Applicant's invention, in varying the breadth or scope of the definition of the invention.

Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, restriction between the claims should not be required. See MPEP §806.03.

In the event the restriction requirement is maintained, Applicant elects to prosecute claims 1-25 in this application.

Respectfully submitted,

Date: July 6, 2005

Thomas E. Hill

Thomas E. Hill, Reg. No. 28,955
Attorney for Applicant
EMRICH & DITHMAR LLC
125 S. Wacker Drive, Suite 2080
Chicago, IL 60606-4401
Tel: 312-663-9800
Fax: 312-633-9822
Email: emrichtom@aol.com